



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,592	07/31/2001	Brian Bodmer	LS/0023.00	5999
7590 05/15/2008				
JUDITH A. SZEPESE BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025				
EXAMINER				
SHAH, AMEE A				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
05/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/920,592

Applicant(s)

BODMER ET AL.

Examiner

Amea A. Shah

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 58-61, 64-67 and 73-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 58-61, 64-67 and 73-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 1/15/08

DETAILED ACTION

Claims 1-19, 58-61, 74-67 and 73-39 are pending in this action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission of an Information Disclosure Statement filed on January 15, 2008, has been entered and considered.

Examiner Note

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

Claims 1-9, 16, 58-61, 67 and 76-79 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tam et al. 2002/0184116 A1 (hereafter referred to as “Tam ’116) in view of Tam et al., US 2002/0147656 A1 (hereafter referred to as “Tam 656”).

Referring to claim 1.

The prior art Tam '116 teaches a method for an e-commerce retailer to display and sell items of a third party (e.g. Fig. 1) comprising: identifying each item of a third party supplier with a unique identifier (Figs. 5F and 8 and ¶¶0035 and 0036 – note the identifier can be the stock or UPC number, the retailer is the aggregator and the third party supplier is the seller); associating

the unique identifier of the item with an image of the item, said image residing on a computer maintained by the third party supplier (Fig. 5F and ¶0035 – note that the seller selects an image file that can reside on “my computer,” i.e. the seller’s computer); and presenting at least some of the images of third party supplier items to the user for on-line commerce, (Fig. 8 and ¶0078-0079 – note the user is the buyer), with the seller maintaining the images on the seller computer (Fig. 5F). Tam ‘116 also teaches a structure of holding product information for the purpose of selling (see, e.g., Fig. 2).

Tam ‘116 does not specifically teach the images being retrieved from the seller’s computer, identifying each item requested based in part on the identifier in response to an order request, and identifying and generating an order for each item to be sent to the appropriate third party seller.

The related application of the prior art Tam ‘656 teaches a system and method for e-commerce using a catalog wherein the images of the third party supplier items are presented by an e-commerce retailer in response to a product request from a user to the e-commerce retailer (¶¶0071 and 0076 – note the request is comprised of the registration information and the buying habits, and the e-commerce retailer is the aggregator), the product information residing in the seller’s computer is retrieved by the aggregator (¶¶0021, 0025 and 0026 – note that the aggregator maintains a database of pointers product information maintained in the seller’s databases and retrieves such information based on these pointers), and in response to an order request from the user to the e-commerce retailer for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party supplier for each requested item and automatically generating an order for each requested item to be

transparently sent to the third party supplier (§§0037, 0038 and 0047 – note that the buyer selects to purchase one or more of the items from the aggregator catalog, i.e. an order request from the user, the products are identified by their related product numbers and, in order for the order send to the appropriate seller or fulfiller, the appropriate seller is inherently identified).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method and system of Tam '116 to include the teachings of Tam '656 to allow for the images to be retrieved from the seller's computer, to identify each item requested based in part on the identifier in response to an order request, and to identify and generate an order for each item to be sent to the appropriate third party seller. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by and envisioned by Tam '656 in order to have a complete selling system with a complete catalog to facilitate the sale and delivery of goods and services (§§0006 and 0026) and because the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one ordinary skill in the art would have recognized that results of the combination were predictable.

Referring to claims 2 and 3. The prior arts Tams further teach the method of claim 1 wherein the items include products and services (Tam '116, §0018 teaches products and services such as downloading and Tam '656, §0019 discusses how it is old in the art for retailers to sell products and services).

Referring to claim 4. The prior arts Tams further teach the method of claim 1 wherein the images of items include graphic images (Tam '116, Fig. 8).

Referring to claim 5. The prior arts Tams teach the method of claim 1 wherein the images of items include descriptive text (Tam '116, Fig. 8).

Referring to claim 6. The prior arts Tams teach the method of claim 1 wherein a given unique identifier references a corresponding product Stock Keeping Unit (SKU) numbers (Tams '116, Figs. 5F and 8 and ¶¶0035 and 0036 – note the identifier can be the stock number).

Referring to claim 7. The prior arts Tams further teach the method of claim 1 wherein a given unique identifier references pricing information from a third party (Tams '116, Fig. 5G and ¶¶0037 and 0070 discuss the third party including pricing information in the product description and referencing the information from the database and Tams '656, ¶¶0025 and 0084 teach referencing that information through the use of pointers).

Referring to claim 8. The prior art Tams further teach the method of claim 1 wherein a given unique identifier references order fulfillment information (Tam '656, ¶0078 – note that the unique identifier is the transaction identifier and the order fulfillment information includes the seller, fulfiller (if any), and product information). One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in

the art at the time of the invention that doing so would provide for a record of the transactions to be used in the future for such purposes as marketing or auditing.

Referring to claim 9. The prior arts Tams teach the method of claim 1, as discussed above, wherein said step of presenting includes: requesting images from a third party (Tam '116, Fig. 5F and ¶0035 – note that the request is performed by the request for information submitted through the dialog boxes); receiving a list of Uniform Resource Locators (URLs) for said requested images (Tam '656, ¶¶0021, 0025 and 0125 – note the database contains a list of pointers to product information, including images, received from the sellers and that the pointers can be URLs); and displaying an on-line page that displays images retrieved from said URLs (Tam '116, Fig. 8).

Referring to claim 16. The prior arts Tams further teach the method of claim 1 wherein the images are rendered on a Web page for display to the user (Tams '116, Fig. 8).

Referring to claims 58-61, 67 and 76-79. All of the limitations in apparatus claims 58-61, 67 and 76-79 are closely parallel to the limitations of method claims 1-4, analyzed above and are rejected on the same bases.

Claims 10-12, 17, 64 and 75 are rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Baum, US 2002/0065741 A1 (hereinafter referred to as “Baum”).

Referring to claim 10. The prior art Tams teach the method of claim 9, as discussed above, but do not teach wherein the request for images includes background and formatting information of a particular third party. Baum, in the same field of endeavor and/or pertaining to the same issue, teaches a method for distributing images to multiple recipients including wherein requests for images from a third party to be presented to a user include background and formatting information of a particular third party (§¶0072 and 0075 – note that the products/services are photofinishing services/prints of photographic images and that the images of the product are the photographic images).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams to include the teachings of Baum to allow for the request for images includes background and formatting information of a particular third party. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would allow users to be able to consider alterations to the products/images that may better suit their purposes (§¶0072).

Referring to claim 11. The prior art Tams teach the method of claim 1, as discussed above, but do not specifically teach wherein a particular third party provides photo-finishing services and the images correspond to user photographic images. Baum, in the same field of endeavor and/or pertaining to the same issue, teaches a method for distributing images to

multiple recipients including wherein a particular third party provides photo-finishing services and the images correspond to user photographic images (*see, e.g.*, ¶0011). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams to include the teachings of Baum to allow for a particular third party to provide photo-finishing services and the images to correspond to user photographic images. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would allow users to be able to order image prints in a manner that minimizes the user's time, effort and expense (¶0012).

Referring to claim 12. The prior arts Tams teach the method of claim 1 wherein a given third party provides URLs for images, as discussed above, but do not specifically teach wherein URLs are provided for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats. Baum, in the same field of endeavor of e-shopping, teaches a method for distributing images to multiple recipients including wherein a given third party provides URLs for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats (Figs. 5 and 9, and ¶0080).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams to include the teachings of Baum to allow for a given third party to provide URLs for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that

doing so would allow users to have access to view images in various manners to better determine which image to order (§§0072 and 0075).

Referring to claim 17. The prior arts Tams teach the method of claim 1, as discussed above, but do not teach wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party. Baum, in the same field of endeavor of e-shopping, teaches a method for distributing images to multiple recipients including wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party (§0075 – note the unique identifier is the number used to reorder).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior art Tams to include the teachings of Baum to allow for the unique identifier of an item requested by the user to be employed for placing a fulfillment request with a corresponding third party. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would provide for a more seamless and accurate ordering system (§0075).

Referring to claims 64 and 75. All of the limitations in apparatus claims 64 and 75 are closely parallel to the limitations of method claim 17, analyzed above, and are rejected on the same bases.

Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Garfinkle et al. US 6,017,157 (hereinafter referred to as “Garfinkle”).

Referring to claim 13. The prior arts Tams teach the method of claim 1 but do not specifically teach wherein a given third party initially provides smaller thumbnail images of the items and provides larger images in response to user requests. Garfinkle, in the same field of endeavor and/or pertaining to the same issue, teaches a method of processing and distributing digital images wherein a party initially provides smaller thumbnail images of the items and provides larger images in response to user requests (col. 7, lines 4-15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior art Tams to include the teachings of Garfinkle to allow for a given third party to initially provide smaller thumbnail images of the items and to provide larger images in response to user requests. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so allow for suppliers to provide more details at once on a single page by showing a small depiction of a product with larger depictions available upon request, thereby saving valuable advertising space, and for users to get a more accurate depiction of a product by enlarging on a small depiction.

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Lyons et al., US 2002/0077937 A1 (hereinafter referred to as “Lyons”).

Referring to claim 14. The prior arts Tams teach the method of claim 1, as discussed above, but do not teach wherein a given third party evaluates the request for images or

descriptions and automatically indicates whether corresponding items are available. Lyons, in the same field of endeavor and/or pertaining to the same issue, teaches a method for ensuring availability of inventory for electronic commerce, including wherein a given third party evaluates the request for images or descriptions and automatically indicates whether corresponding items are available (§§0045-0046).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior art Tams to include the teachings of Lyons to allow for a given third party to evaluate the request for images or descriptions and automatically indicate whether corresponding items are available. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Lyons that doing so would provide buyers with confirmation that the desired items are actually available and aid them in the purchase decision (§0005).

Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Shmueli et al., US 2002/0143637 A1 (hereinafter referred to as “Shmueli”).

Referring to claim 15. The prior arts Tams teach the method of claim 1, as discussed above, but do not teach wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item. Shmueli, in the same field of endeavor and/or pertaining to the same issue, teaches a portable shopping cart wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item (§0066).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams to include the teachings of Shmueli to allow for the unique identifier associated with a given item to be stored in a user's shopping cart when the user selects the item. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would provide for a more seamless and efficient transaction in ensuring that the item desired can be held in a virtual shopping cart before the buyer must make a final determination whether or not to buy the item.

Claims 18, 19, 65, 66, 73 and 74 are rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams in view of Johnson et al., US 6,505,172 B1 (hereinafter referred to as “Johnson”).

Referring to claims 18-19. The prior arts Tams teach the method of claim 1, as discussed above, but do not teach the method further comprising automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties (claim 18), nor splitting order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties (claim 19). Johnson, in the same field of endeavor and/or pertaining to the same issue, teaches a method for electronic sourcing of items including automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties, and splitting an order including items from

the retailer and items from one or more third parties amongst the retailer and the appropriate third parties (col. 15, line 39 through col. 16, line 15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams to include the teachings of Johnson to allow for automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties, and splitting an order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Johnson that doing so would allow buyers to purchase from multiple vendors at one session (col. 2, lines 8-22).

Referring to claims 65, 66, 73 and 74. All of the limitations in apparatus claims 65, 66, 73 and 74 are closely parallel to the limitations of method claims 18 and 19, analyzed above, and are rejected on the same bases.

Response to Arguments

Applicant did not submit any arguments with the request for continued examination filed January 15, 2008, and the previous arguments submitted October 16, 2007, were addressed in the advisory action mailed on November 5, 2007. However, for the sake of clarity, the arguments of October 16, 2007, are again addressed here.

Applicant's arguments, see Remarks (page 2), filed October 16, 2007, with respect to the rejections of claims 1-19 under 35 U.S.C. §112, have been fully considered and are persuasive. The 35 U.S.C §112 rejections of claims 1-19 has been withdrawn.

Applicant's arguments filed October 16, 2007, with respect the rejections of claims 1-19, 16, 58-61, 67 and 76-79 under 35 USC §103(a) have been fully considered but they are not persuasive. In response to applicant's argument that neither Tams teaches or suggests identifying each item of a third party supplier with a unique identifier because each item is not the same as each product and a UPC or stock number identifies only a product as opposed to an item (Remarks, pages 2-9), the Examiner disagrees. First, a UPC uniquely identifies a product and manufacturer (see Glossary obtained from www.ablt.com) and a stock number uniquely identifies each item stocked in a retailer's warehouse (see Glossary obtained from www.washington.edu). Therefore, the prior art Tams teaches identifying each item with a unique identifier such as a stock number as discussed above. Second, applicant's claims contradict applicant's argument in that claims 2 and 3 define "item" as either products or services and claim 6 defines "unique identifier" as a SKU number, which can be represented by a UPC (see Common Terms and Definitions of www.vendorcompliance.info). Therefore, the item of claim 1 can be a product and a UPC can be a unique identifier.

In response to applicant's argument that the prior art does not teach or suggest the limitation of presenting at least some of the images in response to a product request because Tams described obtaining images prior to any information request of a buyer (Remarks, pages 2-9), the Examiner disagrees. Tam '656, as discussed above, teaches the aggregator creating a catalog based on user registration and user purchases and creating a user history of products

requested prior, i.e. a user product request, and giving the term “request” its broadest, reasonable interpretation, the request can be a specific one-time request relating to a specific product or a more general request in allowing information pertaining to particular products to be provided to the user. Furthermore, Tam ‘656 teaches that catalogs can be made specifically for a particular user pertaining to specific products of interest to that user (¶¶0069 and 0074-0075)

Conclusion

This is a continued examination and all claims are drawn to the same invention claimed earlier in the application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered earlier in the application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is (571)272-8116. The examiner can normally be reached on Flex-time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art Unit
3625

AAS

May 9, 2008